

## REMARKS

Claims 4 to 8 are pending in the present application. Reconsideration of those claims in view of the below remarks is respectfully requested.

Claims 4 to 6 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,101,602 to Fridrich ("Fridrich reference") in view of U.S. Patent No. 6,504,941 to Wong ("Wong reference").

Applicants respectfully submit that the Fridrich reference purportedly concerns a digital image that is authenticated by an embedded pattern created by hashing the image and adding a signature element. And, to determine whether the image is authentic, the Fridrich reference recites that *one retrieves the watermark by subtracting the watermarked image from the original to obtain the difference, and the value of the correlation between the difference thus obtained and the smoothed pattern determines the presence or absence of the watermark.*

Applicants respectfully submit that the Wong reference purportedly concerns a watermark insertion procedure which computes a hash function and then combines the output of the hashed function of a modified image block, a key and various image parameters with a block of the watermark bitmap, resulting in a combined image block. The Wong reference further refers to the watermark extraction procedure as using the hash function to calculate a digest of values, resulting in a hashed output, the hashed output being combined with the second image block, preferably using an exclusive OR function, and the result of the combined hashed output with the second image block being a block of the extracted watermark.

In contrast, claim 4 of the present application is directed to a method for generating a digital watermark for an electronic document, including ***providing a secret key for making the watermark visible, restoring the document to an original state by removing the watermark using the secret key, determining a hash value of the restored document, and verifying ownership of the document by comparing the hash value of the restored document and the first hash value.***

Applicants respectfully submit that the Fridrich and Wong references (alone or in combination) do not teach or suggest such features as in claim 4. For example, the Office Action cites the Wong reference at Fig. 10A and col. 2, line 59 to col. 3, line 9, which recites that a system may be employed using a hash value, *or alternatively*, a secret key. While the Fridrich reference recites that the watermark will also "contain an important piece of information uniquely connected to the author of the image," the Fridrich reference does not further elucidate what that might be. And, the Fridrich reference does not involve hash functions and/or secret keys. That is, the Wong reference does not include any express motivation for combining use of a secret key in the method of the Fridrich reference. It is not enough to view that a benefit of a combination of certain parts of multiple references is

enough to satisfy the required level of motivation. Hopefully, most applications claim inventions that are more useful and/or beneficial than predecessor systems and methods.

The law requires that to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest *each claim element* and *it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim.* (See *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990)). Accordingly, it is respectfully submitted that claims 4 to 6 are allowable over the Fridrich and Wong references.

Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) over the Fridrich and Wong references further in view of U.S. Patent No. 6,636,615 to Rhoads. Claims 7 and 8 depend from claim 4 and, as discussed above, are believed allowable over the Fridrich and Wong references (alone or in combination) for at least the same reasons. The Rhoads reference purportedly concerns two or more digital watermarks, with different characteristics, embedded in a document, for which characteristics are chosen so that the watermarks will be affected in different manners if the document is subsequently copied or reproduced, involving a detection process or mechanism which reads two or more of the watermarks and compares their characteristics. The Rhoads reference does not cure the deficiencies of the Fridrich and Wong references – discussed above – even when taken in combination. Accordingly, Applicants respectfully submit that claims 7 and 8 are allowable over the cited art.

It is therefore respectfully submitted that claims 4 to 8 are allowable.

#### CONCLUSION

In view of the foregoing, it is believed that claims 4 to 8 are allowable. It is therefore respectfully requested that the present application issue.

Respectfully submitted,

KENYON & KENYON LLP

Dated: Feb 22, 2007

By: Richard L. Mayer *By Richard L. Mayer*  
Richard L. Mayer (Reg. No. 22,490)

KENYON & KENYON LLP

One Broadway

New York, New York 10004

(212) 425-7200

**CUSTOMER NO. 26646**